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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/075,698

02/14/2002

Stephen G. Dick

I-2-164.2US

9984

24374

7590

11/17/2004

VOLPE AND KOENIG, P.C.

DEPT. ICC

UNITED PLAZA, SUITE 1600

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EXAMINER

KIM, KEVIN

ART UNIT

PAPER NUMBER

2634

DATE MAILED: 11/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/075,698

Applicant(s)

DICK ET AL.

Examiner

Kevin Y Kim

Art Unit

2634

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02-14-2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2/14/02, 06/01/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-17 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 09/826,547 ("parent application"). Although the conflicting claims are not identical, they are not patentably distinct from each other because broader application claims would have been obvious in view of narrower issued claims (see *In re Emert*, 124, F.3d 1458, 44 USPQ 2d 1149).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Representative claim 1 is first discussed. Application claim 1 and parent application claim 1 are both drawn to a method of adjusting the timing of a base station.

Both claims recites "determining an estimation of a timing accuracy" of each base station" and, for each base station "having a timing accuracy over a threshold," measuring "an estimated time difference" between the base station a neighboring base station, and adjusting the timing of the base station based on the measurement. Application claim additionally recites the

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steps of “receiving a first message...to transmit a communication burst”, “receiving said communication burst at said neighboring base station” for measuring the time difference between the base station and the neighboring station.” These additional steps are implicitly included in the parent claim 1 reciting “determining an estimated time difference between that over threshold base station and the neighboring one base station” because the transmission of a burst signal between two communication systems is a most commonly way of measuring the time difference between the two. Thus, application claim 1 merely broadens the scope of parent application claim 1 by eliminating the step of “updating the estimation of that over threshold base station wherein the updated estimation indicates a worse timing accuracy than the neighboring one base station.”

Application claims 9 and 10 similarly reads on parent application claim 1 since it only differs from claim 1 in that the communication burst, used for measuring timing difference measurement, is transmitted by the neighboring base station, which limitation is implied in parent application claim 2.

Application claims 2 and 11 additionally calling for “updating each said first base station’s estimated timing accuracy, wherein the updated timing accuracy estimating indicates a worse timing accuracy than said neighboring base station, in combination with claim 1, reads on parent claim 1 reciting the same limitation as discussed above.

Application claims 3 and 12 defines the same subject matter of parent claim 4.

Application claim 4 and 13 defines the same subject matter of patent claim 5.

Application claims 5-8, 14-17 calling for the use of “a radio network controller,” though not explicitly recited in parent application claims, transmission of a signal at base station is under

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control of a controller, that transmits commands/ "messages" to appropriate part of the station to enable transmission, estimation and measurement.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin Y Kim whose telephone number is 571-272-3039. The examiner can normally be reached on 8AM --5PM M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Chin can be reached on 571-272-3056. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

kvk



CHIEH M. FAN
PRIMARY EXAMINER